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EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/766,934
Filing Date: January 22, 2001
Appellant(s): WRIGHT, CARL A.

John g. Posa
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/6/2005

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 14 and 15 have been amended subsequent to the final rejection.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

An after-final amendment received on 4/6/2005 correcting the dependency of claims 14 and 15 has been acknowledged and entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

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(7) Grouping of Claims

The rejection of claims 1-4, 12 and 14-20 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,493,685

ENSEL

12-2002

US PG-PUBLICATION # 2001/0014878 A1, " Transaction Method and Apparatus"; to Mitra et al., Publication date, Aug 16, 2001

US PG-PUBLICATION # 2001/0009002A1, " METHOD and APPARATUS for PROCESSING BILLING TRANSACTIONS"; to Logan et al.; Publication date July 19, 2001

European Patent; EP590332A1 to Kammerl, Assignee: Siemens; Publication date: April 6, 1994.

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(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims: A copy of Final rejection mailed on 11/1/2004 is being reproduced below:

QUOTE: "

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim 12 contains subject matter, "selecting a language in which to produce the bill and converting all correlated data to the selected language prior to generating the bill", which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
A person shall be entitled to a patent unless –
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 16-17, 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Ensel et al. 9US Patent 6,493,685 B1), hereinafter, referred to as Ensel.

Regarding claim 1, Ensel discloses a method for providing particularized billing services, the method comprising the steps of:

selecting a client for whom a bill is to be produced, and performing the following operations within a local, expanded, or global computing environment (see at least col.3, line 66-col.4, line 38, wherein Ensel discloses presenting bills to the consumer as per the format specified by the customer via different distribution channels, such as Internet site, Email, personal digital assistant, etc. which all satisfy to operate in a local, expanded, or global computing environment. In order to present the bill to the consumer, as per the consumer specified format, the step of selecting that consumer will be inherent. See also col.8, lines 14-25, which discloses presenting bills to customers 80 and it would be inherent to select customers for presenting the bill as per the customer specified format);

extracting a list of software objects from a library of objects, each object being operative to generate a predefined bill format with specific fields for the selected client, invoking at least one of the software objects to collect data pertinent to the client and to the specific fields in the bill format, and producing the bill having the defined bill format, with the data collected for the selected client in the appropriate fields (see at least the following segments:

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col.4, lines 17-39, " In order to carry out the task of presenting the bills to the consumer, the IIP must have access to the "raw" billing data from the biller. This access can be accomplished either through direct access by the IIP to the accounting systems of the biller or through a data feed from the biller to the IIP. Once the billing data has been received by the IIP, the IIP formats the billing data for storage in its own internal database and then performs the task of formatting the bill for the particular channel(s) of distribution selected by the customer. Each biller has its own format and content for its "raw" billing data. Each channel of distribution has a distinct format and restrictions on content. Each customer has its own selected preference(s) for the channel on which the bill is to be presented. In light of all of these variables, the function of correctly formatting a particular bill for a particular customer is a significant task for the IIP. The present invention performs this formatting task using relational and object oriented databases which are the core of the BAP ", and also Figs.2, 5, and

col.10, line 3-col.13, line 2, "FIG. 2 illustrates an overview of structure of the elements of the present invention as well as the processing and data flow. Element 200 illustrates the structure of the Biller Acquisition Platform (BAP). The central feature of the design of the BAP 200 is that it is a database driven system. The BAP 200 includes a database server 202 having, for example, six database including an Enrollment file 205; a Bill Summary file 210; an E-Bill file 215 containing both current and historical data related to E-Bills; a Template file 200 containing the templates required to format electronic bills for the various channels of distribution 310-320; In a preferred embodiment of the present invention, the E-Bill file 215 is an object oriented file in which the E-Bills are stored as objects. The E-bill file 215 can be both industry specific and/or biller specific. For example, if the IIP 20 has several utility billers, a standard format for a utility bill can be derived (e.g., a graph illustrating the customer's usage). Within the standard format, each utility biller can customize the format of its own bill to be presented to its customers 80. Alternatively, each biller can custom format the entire look and feel of its bill.....", and

col.12, lines 12-18 and lines 31-42, " if the biller 5 desires to maintain electronic data for all of its customers 80, in anticipation of the customers 80 eventually signing up for electronic bill presentment. In such a case, the IIP 20 is able to immediately present an electronic bill to the previous paper customer 80. Element 245 is a reformatting processor which reformats the legacy billing data from the biller 5 in the appropriate format for inclusion on the database server 202. The billing data for the electronic bills is passed from the splitter 255 to the reformatting processor 245 ... The details of the formatting by reformatting processor 245 varies from biller to biller and is driven by the format of the billing data provided by the biller. The reformatting processor 245 feeds the Summary data file 210 and the E-Bill database 215 with the data as described above with respect to each of these databases 210, 215. "

Note: The above segments disclose that a list of software objects in the form of E-Bills are stored in an E-bill file 215 which corresponds to the claimed library of objects and that retrieving the billing data, formatting the bill format, as specified by the consumer, and presenting the bill to the consumer correspond to the claimed limitation of invoking a software object to collect data and producing the bill with the collected data in appropriate fields. As regards appropriate fields, please see col.10, line 21-col.11, line 5 which describes an E-bill file 215 varying from biller to biller and includes fields such as, customer's name, account number, address, etc. and this information is collected by the IIP to present the bills to the customers. See also col.10, line 21-col.14, line 53).

Regarding claim 2, Ensel discloses that the method of claim 1, wherein a portion of the collected data is correlated to more than one of the specific fields in the bill format (see at least col.10, line 21-col.11, line 5, which describes an E-bill file 215 varying from biller to biller and includes fields such as, customer's name, account number, address, etc. and this information is collected by the IIP to present the bills to the customers. The information collected on customer's name, address, account number, biller's information, account balance, etc. is the collected data which is correlated to more than specific fields in the bill format. See also col.10, line 21-col.14, line 53).

Regarding claims 3-4, Ensel, does show that the collected data further comprises detailed information pertinent to a billing account of the client and segmenting the detailed information into

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different portions of the bill (see at least col.10, line 21-col.14, line 53. The details of the charges on a credit card plus marketing inserts correspond to the claimed detailed information pertinent to a billing account which is segmented into different portions of the bills as details about charges and marketing/advertising information).

Regarding claim 16, Ensel discloses that the method of claim 1, wherein the defined bill format further comprises a corrected bill image (see col.15, lines 24-26, " *spot check bills prior to publication; and provide full audit control over all add/change/delete activity.* " . Note: checking bills and being able to execute add, change and delete activity corresponds to generating a corrected bill image)

Regarding claim 17, Ensel discloses that the method of claim 1, wherein producing the bill further comprises one or more of the following: presenting a bill image on a display device, printing a bill, sending a bill via email, and sending a bill via facsimile (see at least col.8, lines 14-25, "*regular paper mail ...e-mail ...*" and col.8, lines 56-62, "*Other existing channels include telephone, pagers...interactive cable television....facsimile....*").

Regarding system claims 18-19, their limitations are closely parallel to the method claims 1-4, and 16-17 and are therefore analyzed and rejected on the basis of same rationale. Also see FIGS. 1-6. The IIP 20 being capable of providing a billing control application through application server 240 (see Fig.2) and instructions for a bill having a predetermined format for a client (see at least col.6, line 11-col.10, line 2) . The client usage data is in Enrollment database 205 (see FIGS 2 and 5) which includes information relevant to one or more clients and corresponds to one or more client usage data sources from which data pertinent to the predetermined format and to the specific client are retrieved and used to produce a particularized bill format (see col.10, line 3-col.12, line 43. Also see col.16, line 60- col.17, line 40).

Regarding claim 20, Ensel discloses that the system of claim 18, wherein the billing server application further comprises interactive and batch functionality facsimile (see at least col.8, lines 14-25, "*regular paper mail ...e-mail ...*" and col.8, lines 56-62, "*Other existing channels include telephone, pagers...interactive cable television....facsimile....*". Note: presenting bills via paper mail or email represent batch functionality while presenting bills via interactive cable television represent interactive functionality.).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.1 Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ensel and further in view of Siemens (EP 590332 A1).

Regarding claim 12, please note that it has been rejected under first paragraph of 35 U.S.C. 112 as being not enabled. Ensel teaches particularized billing services as analyzed and discussed in claim 1 above. Ensel does not disclose the steps of selecting a language in which to produce the bill and converting all correlated data to the selected language prior to generating the bill. However, Siemens discloses (see at least the "Abstract" and "Advantage", " *An internationally applicable system is used for a communication network between different countries and each country (A) has transit nodes to allow a conversion to be made between the source language and a neutral global language (GS). This can then be transmitted to a number of different countries and can be translated. The process is bidirectional. ADVANTAGE - Use of global language together with translation programs installed in each country provides reduction in processing in comparison with system in which country has to carry*

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translation programs for all other countries, and reduces number of communication translation programs "). In view of Siemens, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Ensel to incorporate the feature of selecting a language in which to produce the bill and converting all correlated data to the selected language prior to generating the bill because it would help the system for allowing a conversion to be made from a source language to the native language of the consumer and would provide reduction in processing in comparison with system in which country has to carry translation programs for all other countries, and reduces number of communication translation programs as explicitly suggested in Siemens.

5.2 Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ensel and further in view of Mitra et al. (US 20010014878 A1), hereinafter, referred to as Mitra.

Regarding claim 14, Ensel teaches particularized billing services as analyzed and discussed in claim 13 above. Ensel does not disclose producing a closing bill. However, in the field of same endeavor, Mitra teaches producing a closing bill (see at least page 9, paragraph 0092, "*..... The controller 202 may also indicate that a final bill may be issued to the canceling buyer and if the buyer makes a final payment, the controller 202 will forward the payment to the unpaid sellers. Then, the controller 202 goes to step 1019. In step 1019, the controller 202 sends a final bill to the buyer for the shortfall and goes to step 1021. In step 1021, the controller 202 determines whether a final payment has been received from the canceling buyer.*". Note: In Mitra, Final bill corresponds to the claimed closing bill.). In view of Mitra, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Ensel to incorporate the feature of producing a closing bill because it would enable the system to present final bills to the consumers when they close or cancel the accounts.

5.3 Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ensel and further in view of Logan et al. (US 20010009002 A1), hereinafter, referred to as Logan.

Regarding claim 15, Ensel teaches particularized billing services as analyzed and discussed in claim 13 above. Ensel does not disclose producing a duplicate bill. However, in the field of same endeavor, Logan teaches producing a duplicate bill (see at least page 8, paragraph 0096, "*....Post production activities may include, for example, storing a copy of a bill image as generated by each BPW 506 in the database for later access by a CSR on-screen in case a customer wishes to discuss an old or newly generated bill. Thus an archive database of customer bills is maintained within the system for some period of time so that images may be called up wherein the images will match the hard copies generated and mailed by the bill renderer.*". Note: In Mitra, storing a copy of a bill corresponds to producing a duplicate bill.). In view of Logan, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Ensel to incorporate the feature of producing a duplicate bill copy because it would help the system for later access in case a customer wishes to discuss an old or newly generated bill as suggested in Logan. Also see page 12, paragraph 0141.

6. *Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.*

(11) Response to Arguments:**A. The rejection of claim 12 under 35 U.S.C. 112, first Paragraph.**

The applicant has made a conclusive statement of disagreement, see page 3, lines 1-4 without providing any reasoning or facts/evidence against the arguments proposed by the examiner in his rejection of claim 12 under 35 USC 112, first, paragraph as presented on page 2, paragraph 2.2 and pages 4-5, paragraph 3. As analyzed in the final office action, claim 12 contains subject matter, " *selecting a language in which to produce the bill and converting all correlated data to the selected language prior to generating the bill* ", which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Therefore, the rejection of claim 12 under 35 USC 112, first, paragraph is sustainable.

B & C . The rejection of claims 1-4 and 16-20 under 35 U.S.C. 102 (e).

The applicant arguments, see page 3, line 20-page 5, 25, are directed to his statements/interpretation that the reference Ensel (a) does not describe any mechanism for the creation of bill content whereas the instant application is focused on the creation of bill content (b) clearly teaches away from the actual generation of a particularized bill content and (c) does not teach creating objects but receives these objects from external. The examiner respectfully disagrees for the following reasons:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the applicant's invention is directed to creation of bill content) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 1 recites collecting data pertinent to the client and to the specific fields in a bill format and producing/generating the defined bill format but does not recite creating bill content because the bill content already exists and is not created but instead it is collected and applied to the specific fields to the bill format. This fact is also supported in the " Summary of Claimed Subject Matter" on page 2, lines 1-15, "*At least one of the software objects is invoked to collect data pertinent to the client and to the specific fields in the bill format.One or more client usage data sources from which data pertinent to a bill having a predetermined format and to the specific client are retrieved and used to generate a bill*", and nowhere it teaches creating the bill content because it already exists. In the instant case, Ensel, as described in the Final office action on pages 5-7, reads on the limitations of claim 1, that is selecting a client....., extracting a list of software objects....., invoking at least one of the software objects..., and producing the bill.....

The applicant argues, see page 5, lines 13-22 that the above cited examiner's argument (please note: this argument was also submitted by the examiner in the final office action on pages 2-3 in his response to the applicant's arguments) that the "examiner is simply incorrect. Claim 18 (and therefore claims 19 and 20) include, among other limitations, client usage data sources operative to generate bill having content particularized for that

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client...". In response, the examiner would like to point out that claims 18-20 do not recite the limitation creating bill content but instead they claim the subject matter of "receiving instructions about a predetermined bill format required for a client and a data source for retrieving data pertinent to the format for that specific client", hence both format of the bill and the data to be used for generating the bill already exist but they have to be collected and provided, which Ensel teaches see col.10, lines 21-49,

"The Enrollment database 205 contains all of the information relevant to the customers 80 of the biller 5. Examples of the type of information included in Enrollment database 205 includes, but is not limited to: customer name, biller account number, address, home phone, office phone, fax number, pager number, social security number, date of birth, maiden name, a 'password'; a preferred presentment vehicle (channel of distribution) and alternate presentment vehicles; customer presentment preferences (e.g., present my bill as soon as available, at the end of month, exception presentment (only present my bill if dollar amount exceeds a limit, otherwise automatically pay the bill, generate a paper bill if condition X occurs . . .)); presentment configuration data (e.g., Email address, Email system/protocol, browser type and version . . .); bill format preferences (e.g., send me summary only, partial details, full details . . .); reminder preferences (e.g., as soon as possible, at end of month, 5 days before due date, on due date, 5 day late, no reminder . . .); reminder channel (e.g., email, paper mail, fax, phone call, beeper . . .); preferred payment mechanism, a plurality of (e.g., nine) alternate payment mechanisms (i.e., IIP 20 needs to know all the payment options with respect to the client); payment preferences (e.g., preauthorized, on due date, at end of month, full or fixed amount, automatic within limit); and solicitation preferences (e.g., no solicitations, by industry (airlines, investments, . . .); balance information (provided by a bank), credit limits (defined by the issuer) and other limits (defined by the customer 80).

" , wherein collecting of the data relating to a specific client, such as the customer's present preferences, presentment configuration data, bill format preferences, payment preferences, solicitation preferences correspond to retrieving data from a client usage data source specific to that client and Ensel teaches using such client preferred/specified data to generate the bill as per a predetermined format.

The applicant's statement that the Ensel's disclosure teaches away from the actual generation or creation of bill content (see page 5, lines 1-2) is not relevant because (a) as analyzed above the applicant has not claimed generation of bill contents

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and (b) the allegation that the Ensel reference teaches away from the actual generation of a particularized bill content is relevant for obviousness type rejections under U.S.C 103 (a) in considering prior art such that it does not teach away from the claimed invention and is not relevant to anticipation basis 102 (e) rejection. As detailed in the final office action, see pages 5-9 the examiner has demonstrated that Ensel anticipates the limitations of claims 1-4, and 16-20.

The applicant argues that Ensel does not teach creating objects but receives these objects from external source. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the applicant's invention is directed to creation of objects and that these objects are not received from an external source) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 1 recites extracting software objects from a library of objects and invoking them to generate bills **but does not recite creating objects and that these objects are not received from an external source.**

For the above reasons, it is believed that the rejections of claims 1-4, and 16-17 should be sustained as being anticipated by the reference Ensel.

D. **The rejection of claim 12 under 35 U.S.C. 103 (a).**

Note: The applicant has not provided adequate traversed the rejection of claim 12, under 35 USC.112, first paragraph, as analyzed above. The applicant's traversal of the rejection of claim 12 under 35 USC 103 (a) is directed to the reasoning that the examiner has not provided a reason as why one of an ordinary skill in the art would be required to modify the prior art to arrive at the applicant's invention and that there must be something in the prior art to suggest the proposed modification and as such has used hindsight gained from the inventor's knowledge to combine the prior arts of Ensel and Siemens. The examiner respectfully disagrees for the following reasons:

In response to applicant's argument that the prima facie case of obviousness has not been established, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, as acknowledged by the examiner in the final office action, Ensel does not disclose the step of selecting a language in which to produce the bill and converting all correlated data to the selected language prior to generating the bill. However, Siemens discloses, while communicating globally among countries using different languages, the concept of selecting a neutral global language in which to convert the data from the source language to the global neutral language to

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enable the billers from a foreign country to present the bill in a language which can be understood by the customer instead of providing the bill in the source language, which the customer may not understand or know and also reducing the number of translation programs from many different languages to other native languages. Thus the combined teachings of Ensel and Siemens would have suggested to one of an ordinary skill in the art that bills from one country in one source language can be provided to the customer in a neutral global language by converting all the data of the source language in the customer's preferred global natural language format because it will enable the combined system to (a) communicate billing data from sources using different languages by selecting a neutral global language in which to convert the data from the source language to the global neutral language to enable the billers from a foreign country to present the bill in a language which can be understood by the customer instead of providing the bill in the source language, which the customer may not understand or know and also reducing the number of translation programs from many different languages to other native languages.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

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reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the present case, as analyzed above it would be obvious to one of an ordinary skill in the art that the teachings and suggestions have been taken from Ensel and Siemens to combine the two references and not from the applicant's knowledge.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the prior art of Siemens teaches to provide communication data, which includes bills from one source, such as the vendor's country having a source language different from that of the customer's language by converting the source data to another language because that will enable the customer to receive the communication, that is billing data in a global neutral language which he can understand rather than in the source language which he cannot understand. Therefore, to one of an ordinary skill in the art that bills from one country in one source language can be provided to the customer in a neutral global language by converting all the data of the source language in the customer's preferred global natural language format because it will enable the combined system to (a) communicate billing data from sources using different languages by selecting a neutral

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global language in which to convert the data from the source language to the global neutral language to enable the billers from a foreign country to present the bill in a language which can be understood by the customer instead of providing the bill in the source language, which the customer may not understand or know and also reducing the number of translation programs from many different languages to other native languages. Therefore, it would have been obvious to one of an ordinary skill in the art that bills from one country in one source language can be provided to the customer in a neutral global language by converting all the data of the source language in the customer's preferred global natural language format because it will enable the combined system to communicate billing data from sources using different languages by selecting a neutral global language in which to convert the data from the source language to the global neutral language to enable the billers from a foreign country to present the bill in a language which can be understood by the customer instead of providing the bill in the source language, which the customer may not understand or know and also reducing the number of translation programs from many different languages to other native languages.

In view of the foregoing the rejection of claim 12 is sustainable under 35 USC 103 (a).

D. **The rejection of claim 14 under 35 U.S.C. 103 (a).**


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The applicant argues that there is a lack of teaching or suggestion to combine the references but there is no disclosure whatsoever in Ensel with respect to the generation of a closing bill and as such there is no prima facie obviousness. The examiner respectfully disagrees. In response to applicant's argument that the prima facie case of obviousness has not been established, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, as acknowledged by the examiner in the final office action, Ensel does not disclose the step of producing a closing bill and in order to overcome this deficiency it is combined with the teachings of Mitra et al ((see at least page 9, paragraph 0092, "..... *The controller 202 may also indicate that a final bill may be issued to the canceling buyer and if the buyer makes a final payment, the controller 202 will forward the payment to the unpaid sellers. ... In step 1019, the controller 202 sends a final bill to the buyer for the shortfall and goes to step 1021... ..*". Note: In Mitra, Final bill corresponds to the claimed closing bill.)). In view of Mitra, the combined teachings of Ensel and Mitra would have suggested to one of an ordinary skill in the art at the time of the applicant's invention to issue a final bill, that is a closing bill to those customers who want to stop any future transactions and terminate the present relationship, as explicitly suggested in the prior art of Mitra et al.

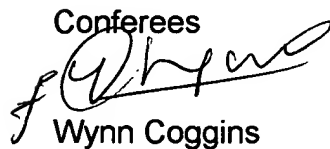
E. The rejection of claim 15 under 35 U.S.C. 103 (a).

The applicant argues that there is a lack of teaching or suggestion to combine the references of Ensel and Logan and that there is no disclosure whatsoever in Ensel with respect to the generation of a corrected bill and as such there is no prima facie obviousness. The examiner respectfully disagrees because the applicant's arguments are not relevant. Claim 15 recites producing a duplicate bill and not a corrected bill. Claim 16 recites generating a corrected bill which is anticipated by Ensel as analyzed by the examiner in the final office action on page 8.

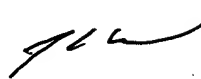
Art Unit: 3625

Respectfully submitted,

Yogesh C Garg
Primary Examiner
Art Unit 3625


YCG
July 11, 2005

Conferees

Wynn Coggins
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